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PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant(s): Kujawski et al. Examiner: J.M. Wollschlager
Application No.: 10/822,955 Group Art Unit: 1732
Confirmation No: 3611 Docket: 760-184
Filed: April 12, 2004 Dated: October 18, 2006
For: ULTRASONIC CRIMPING
OF A VARIED DIAMETER
VASCULAR GRAFT

Commissioner for Patents
P.O. Box 1450
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Signed: Barbara Thomas/

RESPONSE TO RESTRICTION REQUIREMENT

Sir:

This in response to the Requirement for Restriction, mailed September 20, 2006, a
reply to which is due one month, i.e., October 20, 2006.

REMARKS

The application is subject to a restriction requirement. The Examiner requires
restriction among the species of the claimed invention as shown in claims 1-14 (Group I)
and claims 15-22 (Group II).

Applicants provisionally elect Group I. The restriction requirement, however, is respectfully traversed and reconsideration is requested in view of the following remarks.

The Examiner has restricted the invention under 35 U.S.C. §121 into the following groups:

- I. Claims 1-14, drawn to a method of crimping a varied diameter graft in class 264/320.
- II. Claims 15-22, drawn to a system and mandrel for crimping a varied diameter graft in class 623/1.28.

Applicants provisionally elect to prosecute Group I, claims 1-14, with traverse.

The Examiner has stated that the inventions are distinct, each from the other because inventions I and II are related, as process and apparatus for its use. The Examiner, however, does not specifically allege why the species are patentably distinct.

Applicants' acknowledge that under MPEP, §806.05(e) that inventions are distinct if the following can be shown:

- (1) that the process as claimed can be practiced with another materially different apparatus or by hand, or
- (2) the apparatus as claimed can be used to practice another and materially different process.

The Examiner has not, however, specifically alleged why the inventions are distinct. According to MPEP 803, the restriction is proper only if the claims are able to support separate patents and they are either independent or distinct (806.05-806.05(h)).

Section 803 also states that even if distinct or independent claims exist, examination on the merits is required providing the search can be made without serious burden.

In the instant case, it is apparent from a thorough reading of the specification and the claims that the methods and systems of Groups I and II are one invention in this application. References which disclose the method of Group I would clearly be cited as prior art against those which disclose the system of Group II. The Examiner would certainly feel obligated to consider such disclosure relevant and would not hesitate to cite references relating to one group against the other under 35 U.S.C. §103. For those reasons, Applicants maintain that a co-extensive field of search seems virtually mandated and would not present an undue burden.

Furthermore, the mere fact that of separate classifications is not determinative of a proper restriction. Separate classification is mere a patent office convenience for the purpose of locating pertinent art. It is clear, therefore, that although diversity of classification may be the considered factor in a decision to make a restriction requirement, it should not be a controlling one. The Examiner may not properly rely on separate classifications to support an allegation of separate status in the art. The Examiner has also not made any further allegations as to why this restriction is proper.

For the reasons set forth above, Applicants respectfully request that the requirement for restriction to be withdrawn and consideration of all the claims on the merits be commenced.

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Furthermore, the Examiner alleges that the claims of Group I are directed towards the following distinct species:

Species A, claim 1-8

Species B, claims 9-14

For Group I, Applicants provisionally elect species A, i.e., claims 1-8. This election is made with traverse and prosecution of claims 1-14 on the merits is respectfully requested.

Applicants respectfully submit that claims 1-8 read on Species A as defined by the Examiner of Group I.

As an attempted rational for the requirement of a species election, the Examiner merely states that allegedly the "species are independent or distinct because they are mutually exclusive embodiments." The Examiner, however, has not provided any further indication. Therefore, Applicants respectfully submit that the requirement for the election of the species should be withdrawn as the field of search and the classification for the two species are similar and accordingly do not present a serious burden for the Examiner.

The Commissioner is hereby authorized to charge payment of any additional fees associated with this communication, or credit any overpayment, to Deposit Account No. 08-2461. Such authorization includes authorization to charge fees for extensions of time, if any, under 37 C.F.R § 1.17 and also should be treated as a constructive petition for an extension of time in this reply or any future reply pursuant to 37 C.F.R. § 1.136.